

Hence, claims 1-13, 27-39, 43-50 and 54-61 will be pending upon entry of these amendments. The amendments do not introduce new matter. Accordingly, entry and consideration of these amendments are respectfully requested.

APPLICANTS' INTERVIEW SUMMARY

At the outset, Applicants wish to thank Examiner Jeanine Anne Goldberg and Supervisory Patent Examiners Gary Jones, Jeff Fredman and George Elliot for the courtesies extended to the undersigned agent during the personal interview of December 13, 2002. Applicants' attorney, Paul Fehlner, Ph.D., was also present during the interview.

During the interview, the outstanding claim rejections for obviousness under 35 U.S.C. § 103 were discussed. In particular, Applicants reiterated their arguments that particular HCV primers of the claimed invention were not obvious over the cited prior art. Applicants also explained at length how an abundance of evidence, already of record in the prosecution history of this application, established the invention's non-obviousness.

The Examiner was not persuaded by arguments of the non-obviousness of the 3' non-coding HCV primers but the Examiner did acknowledge that the 5' non-coding HCV primers C69F28, C133R26, C131F25 and C294R25 were novel and nonobvious. Therefore, in order to expedite the prosecution of this application, Applicants have amended the claims to specifically recite those primers that the Examiner has indicated as allowable; *i.e.*, the primers C69F28, C133R26, C131F25

and C294R25. Claims 14-26, 40-42, 51-53 and 62-64, which specify primers that the Examiner maintains as obvious and unpatentable, have been canceled without prejudice or disclaimer.

**THE REJECTIONS FOR OBVIOUSNESS
UNDER 35 U.S.C. § 103 SHOULD BE WITHDRAWN**

Claims 14-26, 40-42, 51-53 and 62-64 have been rejected as obvious over prior art cited in the Office Action. However, Applicants note with appreciation that the Examiner has found the subject matter of the remaining claims (*i.e.*, claims 1-13, 27-39, 43-50 and 54-61) to be non-obvious and allowable.

The rejected claims (*i.e.*, claims 14-26, 40-42, 51-53 and 62-64) have all been canceled in the above amendment, without prejudice or disclaimer. Therefore, it is believed that the rejections for obvious have been obviated and should be withdrawn.

**REJECTIONS FOR INDEFINITENESS UNDER 35 U.S.C. § 112,
SECOND PARAGRAPH, SHOULD BE WITHDRAWN**

Claims 7, 13, 33, 39, 47, 48, 58 and 59 have been rejected for alleged indefiniteness. Specifically, the Examiner has indicated that primer C143F26 lacks antecedent basis in each of these claims. Each of these claims has been amended to delete reference to the C143F26 primer. Accordingly, Applicants respectfully request withdrawal of this rejection.

**THE NON-STATUTORY DOUBLE PATENTING
REJECTION SHOULD BE WITHDRAWN**

Claims 22 and 40-41 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting, as being unpatentable over claims 1-10 of copending application 09/494,103 (hereinafter referred to as "the '103 application"). In response, Applicants respectfully point out that claims 22 and 40-41 have been canceled, without prejudice or disclaimer. It is therefore believed that this double patenting rejection has now been obviated, and should be withdrawn.

CONCLUSION

For the reasons stated above, Applicants believe that the Examiner's rejections of the pending claims have been overcome and that the claims are in condition for allowance. Accordingly, the withdrawal of all objections and rejections, and reconsideration of the application are respectfully requested. The Examiner is, moreover, invited to contact the undersigned representative if she believes that it may advance prosecution of this application. An allowance is earnestly sought.

Respectfully submitted,

Dated: February 5, 2003

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PATENT TRADEMARK OFFICE

Docket No: 2094/1E286US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Jeffrey M. LINNEN and Kevin M. GORMAN

Serial No.: 09/493,353

Art Unit: 1634

Confirmation No.: 2146

Filed: January 28, 2000

Examiner: J. GOLDBERG

For: OLIGONUCLEOTIDE PRIMERS FOR EFFICIENT DETECTION OF
HEPATITIS C VIRUS (HCV) AND METHOD OF USE THEREOF

**EXHIBIT A: MARKED-UP COPY OF AMENDED CLAIMS
SUBMITTED PURSUANT TO 37 C.F.R. § 1.121(c)(1)(ii)**

IN THE CLAIMS:

Claims 7, 13, 33, 39, 47, 48, 58 and 59 should be amended as follows:

7. (Amended) A method as defined in claim 6, wherein said probes
comprise a member selected from the group consisting of:

- (a) 5'-TTTCGCGACCCAACACTACTCGGCT-3' (C252-25-PRB) <SEQ
ID NO. 13> and

- (b) 5'-CCTTTCGCGACCCAACACTACTCGGCT-3' (C252-27-PRB)
<SEQ ID NO. 12> when said forward primer is (C131F25) [or
C143F260]; and

wherein said probes comprise

- (c) 5'-GGGTCCTGGAGGCTGCACGACACTCAT-3' (C96-22-PRB)
<SEQ ID NO. 11> when said forward primer is (C69F28).

13. (Twice Amended) A method as defined in claim 12, wherein said probes comprise a member selected from the group consisting of:

- (a) 5'-TTTCGCGACCCAACACTACTCGGCT-3' (C252-25-PRB) <SEQ
ID NO. 13> and
(b) 5'-CCTTTCGCGACCCAACACTACTCGGCT-3' (C252-27-PRB)
<SEQ ID NO. 12> when said forward primer is (C131F25) [or
(C143F26)]; and

wherein said probes comprise

- (c) 5'-GGGTCCTGGAGGCTGCACGACACTCAT-3' (C96-22-PRB)
<SEQ ID NO. 11> when said forward primer is (C69F28).

33. (Amended) A method as defined in claim 32, wherein said probes comprise a member selected from the group consisting of:

- (a) 5'-TTTCGCGACCCAACACTACTCGGCT-3' (C252-25-PRB) <SEQ
ID NO. 13> and

- (b) 5'-CCTTTCGCGACCCAACACTACTCGGCT-3' (C252-27-PRB)
<SEQ ID NO. 12> when said 5' NCR forward primer is (C131F25)
[or (C143F26)];

wherein said probes comprise

- (c) 5'-GGGTCCTGGAGGCTGCACGACACTCAT-3' (C96-22-PRB)
<SEQ ID NO. 11> when said 5' NCR forward primer is (C69F28);
and

wherein said probes comprise a member selected from the group consisting of

- (d) 5'-GCGGCTCACGGACCTTTCACAGCTA-3' (30PRB25) <SEQ ID
NO. 14>; and
(e) 5'-ATGCGGCTCACGGACCTTTCACAGC-3' (32PRB25) <SEQ ID
NO. 15>.

39. (Amended) A method as defined in claim 38, wherein said probes
comprise a member selected from the group consisting of:

- (a) 5'-TTTCGCGACCCAACACTACTCGGCT-3' (C252-25-PRB) <SEQ
ID NO. 13> and
(b) 5'-CCTTTCGCGACCCAACACTACTCGGCT-3' (C252-27PRB)
<SEQ ID NO. 12> when said 5' NCR forward primer is (C131F25)
[or (C143F26)];

wherein said probes comprise

- (c) 5'-GGGTCCTGGAGGCTGCACGACACTCAT-3' (C96-22-PRB)
<SEQ ID NO. 11> when said 5' NCR forward primer is (C69F28);
and

wherein said probes comprise a member selected from the group consisting of

- (d) 5'-GCGGCTCACGGACCTTTCACAGCTA-3' (30PRB25) <SEQ ID
NO. 14>; and
(e) 5'-ATGCGGCTCACGGACCTTTCACAGC-3' (32PRB25) <SEQ ID
NO. 15>.

47. (Amended) A kit as defined in claim 45, wherein said probes
comprise a member selected from the group consisting of:

- (a) 5'-TTTCGCGACCCAACACTACTCGGCT-3' (C252-25-PRB) <SEQ
ID NO. 13> and
(b) 5'-CCTTTCGCGACCCAACACTACTCGGCT-3' (C252-27-PRB)
<SEQ ID NO. 12> when said 5' NCR forward primer is (C131F25)
[or C143F26]]; and

wherein said probes comprise

- (c) 5'-GGGTCCTGGAGGCTGCACGACACTCAT-3' (C96-22-PRB)
<SEQ ID NO. 11> when said 5' NCR forward primer is (C69F28).

48. (Amended) A kit as defined in claim 46, wherein said probes
comprise a member selected from the group consisting of:

- (a) 5'-TTTCGCGACCCAACACTACTCGGCT-3' (C252-25-PRB) <SEQ ID NO. 13> and
- (b) 5'-CCTTCGCGACCCAACACTACTCGGCT-3' (C252-27-PRB) <SEQ ID NO. 12> when said 5' NCR forward primer is (C131F25) [or (C143F26)];

wherein said probes comprise

- (c) 5'-GGGTCCTGGAGGCTGCACGACACTCAT-3' (C96-22-PRB) <SEQ ID NO. 11> when said 5' NCR forward primer is (C69F28); and

wherein said probes comprise a member selected from the group

consisting of

- (d) 5'-GCGGCTCACGGACCTTTCACAGCTA-3' (30PRB25) <SEQ ID NO. 14>; and
- (e) 5'-ATGCGGCTCACGGACCTTTCACAGC-3' (32PRB25) <SEQ ID NO. 15>.

58. (Amended) A kit as defined in claim 56, wherein said probes comprise a member selected from the group consisting of:

- (a) 5'-TTTCGCGACCCAACACTACTACTCGGCT- 3' (C252-25-PRB) <SEQ ID NO. 13> and

- (b) 5'-CCTTTCGCGACCCAACACTACTCGGCT- 3' (C252-27-PRB)
<SEQ ID NO. 12> when said 5' NCR forward primer is (C131F25)
[or (C143F26)];

wherein said probes comprise

- (c) 5' -GGGTCCTGGAGGCTGCACGACACTCAT-3' (C96-22-PRB)
<SEQ ID NO. 11> when said 5' NCR forward primer is (C69F28).

59. (Amended) A kit as defined in claim 57, wherein said probes
comprise a member selected from the group consisting of:

- (a) 5'-TTTCGCGACCCAACACTACTCGGCT-3' (C252-25-PRB) <SEQ
ID NO. 13> and
(b) 5'-CCTTTCGCGACCCAACACTACTCGGCT-3' (C252-27-PRB)
<SEQ ID NO. 12> when said 5' NCR forward primer is (C131F25)
[or (C143F26)];

wherein said probes comprise

- (c) 5'-GGGTCCTGGAGGCTGCACGACACTCAT-3' (C96-22-PRB)
<SEQ ID NO. 11> when said 5' NCR forward primer is (C69F28);
and

wherein said probes comprise a member selected from the group consisting of

- (d) 5'-GCGGCTCACGGACCTTTCACAGCTA-3' (30PRB25) <SEQ ID
NO. 14>; and

(e) 5'-ATGCGGCTCACGGACCTTTCACAGC-3' (32PRB25) <SEQ ID
NO. 15>.